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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re trademark application of :
Adrienne Vittadini, LLC : Law Office 108
Serial No.: 76/449,099 : Examining Attorney: J. Fickes
Filed: September 12, 2002 :
Mark: ADRIENNE VITTADINI BODY LINES
Class: 25

APPLICANT'S APPEAL BRIEF

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In accordance with the provisions of 37 C.F.R. §§ 2.141-142, Applicant hereby appeals to the Trademark Trial and Appeal Board the decision of the Trademark Examining Attorney refusing registration of the mark ADRIENNE VITTADINI BODY LINES under Section 2(d) of the Trademark Act.

(1) STATEMENT OF FACTS

The application for registration of the subject mark, ADRIENNE VITTADINI BODY LINES for women's hosiery in International Class 25, was filed September 12, 2002 and assigned application serial number 76/449,099 ("the '099 application"). In an Office Action dated March 24, 2003, the Examining Attorney provisionally refused registration of ADRIENNE VITTADINI BODY LINES on the basis of prior pending application No. 78/125,326 ("the '326 application") for the mark BODY LINE PRESTIGIO QUE DA FIRMEZA A TU BELLEZA¹ for use in connection with brassieres, ladies lingerie, in International Class 25. Applicant responded to the Office Action on April 17, 2003 presenting arguments to overcome the provisional refusal and submitting Adrienne Vittadini's consent to use and registration of the subject mark. Applicant also attended to certain informalities, including amendment of the application to claim ownership of ADRIENNE VITTADINI registrations No. 1,241,274 and No. 1,601,002 and others. On August 18, 2003, Applicant filed an Amendment to the '099 application correcting information pertaining to Applicant's entity type. A Notice of Suspension was issued on June 9, 2003 pending the disposition of the '326 application.

¹The application for registration reflects the mark as BODY LINE, PRESTIGIO QUE DA FIRMEZA A TU BELLEZA. The USPTO TDR data base shows that an Examiner's Amendment was issued on June 24, 2004 deleting the comma from the mark.

Applicant diligently monitored the progress of the '326 application. After it matured into registration No. 2,882,908 ("the '908 registration"), Applicant filed a Request to Resume Proceedings in the '099 application. The Examining Attorney issued a second Office Action on March 14, 2005 refusing registration under Section 2(d) on the basis of the '908 registration. The Examining Attorney's refusal was based primarily on the premise that the dominant portion of Registrant's mark is BODY LINE, a phrase also present in Applicant's mark. From that premise, the Examining Attorney concluded that Registrant's and Applicant's marks are virtually the same and that the addition of a house mark is "more likely to add to the likelihood of confusion." Office Action No. 2, p. 2. Applicant filed a Response on May 16, 2005 and contended that the Section 2(d) analysis should examine the marks in their entireties. Moreover, Applicant contended that Applicant's and Registrant's marks are not virtually the same, that the ADRIENNE VITTADINI house mark formed the dominant portion of Applicant's mark, particularly given Applicant's long use of ADRIENNE VITTADINI in commerce, and that the respective marks are not confusingly similar.

Applicant does not contest the Examining Attorney's findings that Applicant's goods (women's hosiery) are related to the goods (brassieres and ladies lingerie) recited in the cited registration. Rather, Applicant contends that the respective marks are not so similar as to be likely to cause confusion under Section 2(d).

(2) ARGUMENT

The Examining Attorney's refusal to register the mark ADRIENNE VITTADINI BODY LINES on the basis of BODY LINES PRESTIGIO QUE DA FIRMEZA A TU BELLEZA is unfounded.

First, and perhaps foremost, Applicant respectfully contends that the respective marks are distinguishable on the basis of appearance, sound, and meaning. While, Applicant appreciates that dominant portions of respective marks should be considered in a Section 2(d) analysis, Applicant cannot understand the Examining Attorney's oft stated position that BODY LINE is the dominant portion of Registrant's mark, particularly given that the term LINE is descriptive and has been disclaimed. Applicant courteously contends that, by their very nature, dominant and descriptive terms are at opposite ends of the trademark analysis spectrum. Moreover, there is no explanation or legal support for the Examining Attorney's position that PRESTIGIO QUE DA FIRMEZA A TU BELLA is "a secondary slogan" (Final Refusal, p. 2), nor for the statement "[c]onsumers are likely to perceive the dominant portion of registrant's mark as 'BODY LINE'" *Id.* Applicant respectfully disagrees.

In his treatise, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 19:65 (4th ed. 2006), Professor McCarthy states: "A disclaimer of a part of a composite is a concession that that part is descriptive" *citing, In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). Professor McCarthy continues, "Since a disclaimer concedes that the term is merely descriptive, arguments to the contrary will not be considered by the Board" *Id.*, *citing, In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, n.4 (TTAB 1988). Similar to the instant case, the Board in the *Pollio Dairy Products* case was considering an ex parte appeal pertaining to a Section 2(d) refusal. Applicant respectfully contends that the argument is equally unconvincing when propounded by the Examining Attorney in the instant case when the Examining Attorney contends that LINE is a dominant term in Registrant's mark. Specifically, Applicant contends that the term LINE should not be included when referring to the dominant portion of Registrant's mark because it is admittedly descriptive. That is not to say, of course, that the term should not

be considered in an analysis under Section 2(d). Rather, it is Applicant's position that the dominant portion of Registrant's mark is PRESTIGIO QUE DA FIRMEZA A TU BELLEZA because of the highly suggestive (if not descriptive) nature of the term BODY in relation to the goods offered under Registrant's mark (i.e., brassieres, ladies lingerie). Indeed, the Examining Attorney herself refers to the descriptive nature of the phrase BODY LINE in Registrant's mark, stating that the Spanish portion "clearly indicates that the purpose of the goods is **to create a more pleasing body line.**" (Final Refusal, p. 2, emphasis added.)

Second, the Examining Attorney fails to recognize ADRIENNE VITTADINI as the dominant portion of Applicant's mark. The evidence of record shows that Applicant and its predecessors-in-interest have used the ADRIENNE VITTADINI mark for more than 20 years. Applicant owns numerous registrations on ADRIENNE VITTADINI for clothing, leather goods, jewelry, and perfume. The Examining Attorney essentially ignored this argument and instead focused on whether the common terms are diluted or descriptive. *Id.* The Examining Attorney then dismissed Applicant's argument, presented in its Request for Reconsideration, that the term BODY is extremely weak in view of the more than 900 marks appearing in the USPTO data base in Class 25. The Examining Attorney contends that such evidence is not persuasive because Applicant's search was only for the term BODY and not the phrase BODY LINE. However, a discussion of whether the common terms of the respective marks are diluted or descriptive should focus on the word BODY. The term LINE is admittedly descriptive and has been disclaimed. Accordingly, Applicant reasserts its position that the term BODY is a weak term when used in connection with clothing. Considering the Examining Attorney's position, the term BODY is diluted and the term LINE is descriptive. Thus, it reasonably follows that Applicant's use of its house mark ADRIENNE VITTADINI serves to distinguish the respective marks. As

the Examining Attorney acknowledges, “In some instances, the addition of a house mark can distinguish marks where the matter in common is diluted or descriptive.” *Id.*, citing TMEP Section 1207.01(b)(iii).

A third error in the refusal to register the subject mark results from the Examining Attorney’s insistence that Registrant’s mark is, essentially, not a unitary mark, specifically stating:

Registrant’s mark is comprised grammatically of two portions: the phrase “BODY LINE” and the phrase “PRESTIGIO QUE DA FIRMEZA A TU BELLEZA.” As explained above, consumers are likely to interpret the words “BODY LINE” in applicant’s **mark as a whole**. Moreover, the second portion of registrant’s mark appears subsidiary to the first, appearing in a second language and fancifully describing the goods.

Final Refusal, p. 2, emphasis added. Applicant respectfully disagrees with the Examining Attorney’s position. It is well settled that marks examined under a Section 2(d) analysis should be compared in their entirety and not dissected into their component parts. *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920). (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.”) See, also, *McCarthy* Section 11:27. Regardless of what Applicant perceives as the dominant portion of either Registrant’s or Applicant’s respective marks, the marks, as viewed in their entirety, are not similar in appearance, sound or meaning.

The Examining Attorney relies on *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982) in support of the statement, “[w]here marks are otherwise virtually the same, the addition of a house mark is more likely to add to the likelihood of confusion than to distinguish the marks.” Office Action 2, p. 2. This reliance is misplaced. In

the instant case, Applicant's mark (minus the ADRIENNE VITTADINI house mark) is not virtually the same as Registrant's mark. Registrant's mark is BODY LINES PRESTIGIO QUE DA FIRMEZA A TU BELLEZA. The Spanish portion of the mark imparts some degree of connotation or meaning, not to mention purpose. Applicant respectfully contends that it is primarily the presence (if not the exact wording) of the Spanish phrase that will be recalled by consumers in considering Registrant's mark. In this regard, Applicant agrees with the Examining Attorney's statement: "The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks." Final Refusal, p. 3, citing, *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP § 1207.01(a).

The greatest error committed by the Examining Attorney is the following misapplication of the likelihood of confusion test under Section 2(d):

With respect to the applicant's mark, applicant argues that the house mark "ADRIENNE VITTADINI" dominates the product mark "BODY LINES." The examining attorney is not ignoring the presence of the house mark in applicant's mark. But consumers might assume registrant's goods also emanate from "ADRIENNE VITTADINI."

Final Refusal, p. 2, emphasis added.

Here again, the Examining Attorney has impermissibly broken up the subject mark into a house mark (ADRIENNE VITTADINI) and a products mark (BODY LINES). Moreover, the fact that consumers might assume an association between the goods of the Registrant and Applicant is not sufficient to refuse registration. Rather, the assumption must be likely. That is, there must be more than a mere possibility of confusion in order to refuse registration under Section 2(d).

(3) CONCLUSION

ADRIENNE VITTADINI BODY LINES is completely different from the mark BODY LINE PRESTIGIO QUE DE FIRMEZA A TU BELLEZA in appearance, sound, and meaning. The Examining Attorney's finding that consumers might assume that products of Registrant originate from Applicant is an erroneous analysis of likelihood of confusion under Section 2(d). The Examining Attorney's decision should be reversed.

Respectfully submitted,

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that Applicant's Appeal Brief is being filed via the U.S. Patent and Trademark Office's Electronic System for Trademark Trial and Appeals (ESTTA) on March 20, 2006.



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